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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,152	05/03/2002	Karlfried Pfeifenbring	6171-7	8263
21324	7590	11/23/2004		
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			EXAMINER	
			WYSZOMIERSKI, GEORGE P	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,152

Applicant(s)

PFEIFENBRING ET AL.

Examiner

George P Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 and 51-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 15, 18, 33 and 34 is/are rejected.
- 7) ☒ Claim(s) 3, 6, 7, 16, 17, 19-32 and 35-50 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020823.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claims 1-7 and 15-50, drawn to a method for producing an improved cold band.

Group II, claims 8-14 and 51-79, drawn to a cold band.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The two groups do not commonly share all of the technical features of the method of Group I. For example, the Group I method permits coating of the band either before or after annealing, whereas the Group II product requires annealing of a previously coated band.

3. During a telephone conversation with John Konoff, attorney of record on July 15, 2004 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-7 and 15-50. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-14 and 51-79 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshinaga et al. (U.S. Patent 5,690,755).

Yoshinaga discloses a process which includes rolling a steel sheet containing less than 0.5% carbon by an amount between 30-95%, annealing in a continuous annealing furnace at a temperature above 911°C (note particularly a number of the temperatures used in Tables 1 and 6 of Yoshinaga), and galvanically coating the sheet. Thus, all aspects of the claimed invention are held to be fully disclosed by Yoshinaga et al.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshinaga et al.

The Yoshinaga process, described supra, includes a step or step(s) of "in-line annealing hot-dip galvanizing" as recited in claims 16 and 18 of Yoshinaga. It is unclear whether or not this particularly discloses annealing of an already coated material. The examiner's position is that either:

- a) The Yoshinaga disclosure includes such an embodiment, in which case the prior art process would be identical to that presently claimed (in the sense of 35 USC 102), or

b) That Yoshinaga provides one of skill in the art with sufficient information that one would easily be able to carry out the prior art process in such a manner that includes coating followed by annealing. Thus, at a minimum, Yoshinaga et al. is held to create a prima facie case of obviousness of the presently claimed invention.

8. Claims 4, 5, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshinaga et al., as above, in view of Sakuma et al. (U.S. Patent 6,129,992).

The Yoshinaga patent does not appear to disclose any step of coating the steel strips with organic materials, as required by the instant claims. Sakuma, particularly column 9, lines 53-57 therein, indicate that it was known in the art, at the time of the invention, to coat an organic film upon a zinc or alloy plated steel sheet. It would have been an obvious expedient for one of ordinary skill in the art to include such a step when processing steel sheets by the method as disclosed by Yoshinaga et al., e.g. to improve the corrosion resistance thereof.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshinaga et al., alone or in view of Sasaki et al (U.S. Patent 5,425,798).

Yoshinaga does not specifically mention a coating that contains iron, as required by the instant claim. The examiner's position is that iron constitutes a known impurity even in highly pure zinc materials, as evidenced by Sasaki (particularly Sasaki column 3, lines 9-35). Based on this disclosure of Sasaki, one of ordinary skill in the art would have believed that the process of Yoshinaga et al. would result in a coating that contains iron.

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10. Claims 3, 6, 7, 16, 17, 19-32, and 35-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not disclose or suggest a process which includes the two step coating of claims 3, 24-32, and 35-38, the conductive particles embedded in the coating of claims 6 and 39-44, a coating covered with a coating containing conductive particles of claims 7 and 45-50, or a galvanic coating containing the particular elements of claims 16, 17, and 19-23, in combination with the steps as recited in the independent claim.

11. The remainder of the art cited on the attached PTO-892 and 1449 forms is of interest. This art is held to be no more relevant to the claimed invention than the art as applied in the rejections, *supra*.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. Effective October 1, 2003, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
November 22, 2004